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| 09/641,095 | 08/17/2000 | Donald B. Benson | 40016420-0001 | 5295 |
| 26565 | 7590 | 08/11/2005 | EXAMINER | |
| MAYER, BROWN, ROWE & MAW LLP P.O. BOX 2828 CHICAGO, IL 60690-2828 | | | WOO, RICHARD SUKYOON | |
| | | ART UNIT | | PAPER NUMBER |
| | | | | 3639 |

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|-------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/641,095 | BENSON, DONALD B. |
| | Examiner | Art Unit |
| | Richard Woo | 3639 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 May 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 9,13-15,18,21-23 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 21-23 is/are allowed.
- 6) Claim(s) 9, 13-15, 18 and 28 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

- 1) Applicant's amendments filed on May 20, 2005 have been acknowledged and entered.
- 2) Applicant's arguments filed on May 20, 2005, with respect to Claims 18 and 21, have been fully considered and deemed persuasive. Accordingly, the rejection of Claim 18 under 35 U.S.C. 103 and the allowance of Claim 21 are set forth below.
- 3) Applicant's arguments filed May 20, 2005 have been fully considered but they are not persuasive.
 - In response to applicant's argument that the Mayer reference does not teach or suggest the co-mailing system for sorting (or that sorts) the publications by the mail rate, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In this case, the Mayer does disclose the sortation device that sorts the diverse publications. Unless the applicant further submits any structural difference between the claimed sortation device and that of the Mayer reference, the Mayer sortation device is capable of performing the intended use as claimed by the applicant.

Although the applicant's argument that the Mayer reference does not specifically disclose the print head at the co-mailer would be persuasive, it would have been obvious to one having ordinary skill in the art to move the print head from the present location to the co-mailer because Applicant has not disclosed that installing the print head at the co-mailer rather than at the bindery provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the modified system of Mayer because the Mayer reference discloses the system for co-mailing, comprising: a bindery for binding a plurality of signatures and a print head for printing an identifier information on each of the plurality of diverse publications in a customized orientation and a customized placement on a first portion of each of the plurality of diverse publications; and a co-mailer including: a merge stream and a sortation device.

Therefore, it would have been an obvious matter of design choice to modify Mayer to obtain the invention as specified in claim(s).

- In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

4) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

5) Claims 9, 18 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al. (US 5,287,976).

W.R.T. Claim 9, Mayer et al. discloses a system comprising:

a bindery for binding a plurality of signatures, the bindery binding the plurality of signatures to create a plurality of first publications and a plurality of second publications, each of the plurality of first publications and each of the plurality of second publications being an order, the order identifying each of the plurality of first and second publications with each of the plurality of recipients (see Fig. 1; col. 6, lines 21-61);

a print head (18) printing an identifier information on each of the plurality of diverse publications in a customized orientation and a customized placement on a first portion of each of the plurality of diverse publications (see Fig. 1); and

a co-mailer (28' in Fig. 5) comprising:

a merge stream for merging the plurality of first publications and the second publications in the order to mail the diverse publications to the plurality of recipients (see 28'); and

a sortation device (60).

However, Mayer et al. does not expressly disclose the second print head.

When the invention was simply directed to the duplication of parts for a multiplied effect, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) and *St. Regis Paper Co. v. Bemis Co., Inc.*, 193 USPQ 8, 11 (7th Cir. 1977).

Here, the applicant's invention is directed to the co-mailer including two print heads (duplication of the print head). Although having two print heads would have a multiplied effect of printing the information on the publications faster than the system having just one print head, it would have no patentable significance or patentably distinguish over the prior art because Mayer et al. can print the same information on the publication although the printing process may be slower than the one having two print heads. The print head of Mayer et al. can print the information on the multiple areas in a customized orientation and placement of the publications.

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time of the invention to add the additional print head to the system of Mayer et al. for the purpose of printing the identifier information on the publication faster and more efficiently.

The modified Mayer et al. discloses the invention as recited above, but does not further expressly disclose the system having the first and second print heads at the co-mailer instead at the bindery.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to move the print head from the present location (bindery) to the co-mailer because Applicant has not disclosed that installing the print head at the co-mailer rather than at the bindery provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the modified system of Mayer because the Mayer reference discloses the system for co-mailing, comprising: a bindery for binding a plurality of signatures and a print head for printing an identifier information on each of the plurality of diverse publications in a customized orientation and a customized placement on a first portion of each of the plurality of diverse publications; and a co-mailer including: a merge stream and a sortation device.

Therefore, it would have been an obvious matter of design choice to modify Mayer to obtain the invention as specified in claim(s) for the purpose of printing an identifier information on each of the plurality of diverse publications in a customized orientation and a customized placement on a first portion of each of the plurality of the diverse publications.

W.R.T. Claim 18, Mayer et al. discloses a system comprising:

a bindery for binding a plurality of signatures, the bindery binding the plurality of signatures to create a plurality of first publications and a plurality of second publications, each of the plurality of first publications and each of the plurality of second publications being an order, the order identifying each of the plurality of first and second publications with each of the plurality of recipients (see Fig. 1; col. 6, lines 21-61); and

a co-mailer (28' in Fig. 5) comprising:

a merge stream for merging the plurality of first publications and the second publications in the order to mail the diverse publications to the plurality of recipients (see 28');

a sortation device (60) ; and

a co-mailer control module (32, 32') controlling a first print head (18).

However, Mayer et al. does not expressly disclose an additional print head.

When the invention was simply directed to the duplication of parts for a multiplied effect, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) and *St. Regis Paper Co. v. Bemis Co., Inc.*, 193 USPQ 8, 11 (7th Cir. 1977).

Here, the applicant's invention is directed to the co-mailer including two print heads (duplication of the print head). Although having two print heads would have a

multiplied effect of printing the information on the publications faster than the system having just one print head, it would have no patentable significance or patentably distinguish over the prior art because Mayer et al. can print the same information on the publication although the printing process may be slower than the one having two print heads. The print head of Mayer et al. can print the information on the multiple areas in a customized orientation and placement of the publications.

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time of the invention to add the additional print head to the system of Mayer et al. for the purpose of printing the identifier information on the publication faster and more efficiently.

The modified Mayer et al. discloses the invention as recited above, but does not further expressly disclose the system having the first and second print heads at the co-mailer instead at the bindery.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to move the print head from the present location (bindery) to the co-mailer because Applicant has not disclosed that installing the print head at the co-mailer rather than at the bindery provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the modified system of Mayer because the Mayer reference discloses the system for co-mailing, comprising: a bindery for binding a plurality of signatures and

a print head for printing an identifier information on each of the plurality of diverse publications in a customized orientation and a customized placement on a first portion of each of the plurality of diverse publications; and a co-mailer including: a merge stream and a sortation device.

Therefore, it would have been an obvious matter of design choice to modify Mayer to obtain the invention as specified in claim(s) for the purpose of printing an identifier information on each of the plurality of diverse publications in a customized orientation and a customized placement on a first portion of each of the plurality of the diverse publications.

W.R.T. Claim 28, Mayer et al. discloses a system comprising:
a plurality of pockets for receiving the plurality of publications (see Fig. 5);
a merge stream for merging the plurality publications; and
a print head (18) printing an identifier information on each of the plurality of diverse publications in a customized orientation and a customized placement on a first portion of each of the plurality of diverse publications (see Fig. 1).

However, Mayer et al. does not expressly disclose the second print head.

When the invention was simply directed to the duplication of parts for a multiplied effect, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ

378 (CCPA 1960) and *St. Regis Paper Co. v. Bemis Co., Inc.*, 193 USPQ 8, 11 (7th Cir. 1977).

Here, the applicant's invention is directed to the co-mailer including two print heads (duplication of the print head). Although having two print heads would have a multiplied effect of printing the information on the publications faster than the system having just one print head, it would have no patentable significance or patentably distinguish over the prior art because Mayer et al. can print the same information on the publication although the printing process may be slower than the one having two print heads. The print head of Mayer et al. can print the information on the multiple areas in a customized orientation and placement of the publications.

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time of the invention to add the additional print head to the system of Mayer et al. for the purpose of printing the identifier information on the publication faster and more efficiently.

6) Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al. and in view of Delfer, III (US 5,264,665)

W.R.T. Claim 13, Mayer et al. discloses a system comprising:

a bindery for binding a plurality of signatures, the bindery binding the plurality of signatures to create a plurality of first publications and a plurality of second publications, each of the plurality of first publications and each of the plurality of second publications

being an order, the order identifying each of the plurality of first and second publications with each of the plurality of recipients (see Fig. 1; col. 6, lines 21-61); and
a co-mailer (28' in Fig. 5) comprising:

a merge stream for merging the plurality of first publications and the second publications in the order to mail the diverse publications to the plurality of recipients (see 28'); and
a sortation device (60).

However, Mayer et al. does not expressly show the system including a thickness measurement device and scale.

Delfer, III teaches utilizing the thickness measurement device and scale (30 in Fig. 1A) for optimizing the mailing discount rates.

It would have been obvious to a person having ordinary skill in the art at the time of invention to employ the scale and thickness gage by the system, as taught by Delfer, III, for the purpose of optimizing the postal discount for the mailing.

7) Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al. in view of Humes et al. (US 5,377,120).

W.R.T. Claims 14-15, Mayer et al. discloses a system comprising:

a bindery for binding a plurality of signatures, the bindery binding the plurality of signatures to create a plurality of first publications and a plurality of second publications, each of the plurality of first publications and each of the plurality of second publications being an order, the order identifying each of the plurality of first and second publications with each of the plurality of recipients (see Fig. 1; col. 6, lines 21-61); and

a co-mailer (28' in Fig. 5) comprising:

a merge stream for merging the plurality of first publications and the second publications in the order to mail the diverse publications to the plurality of recipients (see 28'); and

a sortation device (60).

However, Mayer et al. does not expressly show the system including a co-mailer merge and sequence module for receiving a plurality of verified sequence list from the bindery, each of the plurality of verified sequence lists containing the order for each of the plurality of publications received from the bindery, the co-mailer merge and sequence module merging each of the plurality of verified sequence lists to create a merged verified sequence list, the merged verified sequence list sequenced in the order to determine the mail rate.

Humes et al. teaches an apparatus for co-mailing mail pieces by taking the various mailing lists, merging and sorting the entries into lowest postal rate groupings and utilizing this merged data base to enable a sequence controller and associated

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device to physically co-mail and address the mail pieces (see Figs. 1-3 and the descriptions thereof; abstract; and col. 2, lines 38-68).

It would have been obvious to a person having ordinary skill in the art at the time of invention to incorporate the co-mailer merge and sequence module of Humes et al. into the co-mailing system of Mayer et al., for the purpose of preparing a plurality of preprinted un-addressed, non-alike mail pieces from un-predetermined sources into grouped bundles organized in a manner to receive low postal rates.

Allowable Subject Matter

8) Claims 21-23 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 571-272-6813. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard Woo
Art Unit 3639
August 05, 2005



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